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OFFICE OF PETITIONS

In re Application of :
Ohnemus, et al. :
Application No. 10/708,441 : DECISION ON PETITION
Filed: 3 March, 2004 :
Attorney Docket No.: 20118/0200853-US0 :
:

This is a decision on the response, considered as a petition, filed on 14 July, 2004, seeking to have accorded to the instant application a filing date of 3 March, 2004--notably, however, Petitioner alleges that the drawings found to be missing from the application "are not necessary for the understanding of the subject matter to be patented."

For the reasons set forth below, the petition is **GRANTED in part** and **DISMISSED in part**, and no petition fee is charged.

The application was deposited on 3 March, 2004.

On 27 May, 2004, the Office mailed a "Notice of Incomplete Nonprovisional Application" indicating that the application was filed without, *inter alia*, drawings as required under 35 U.S.C. §113 (first sentence) and that no filing date has been granted.

On 14 July, 2004, Petitioner replied submitting the instant petition, alleging electronic filing of the application with 32 sheets of drawings, and Petitioner also submitted copies of the drawings (32 sheets, Figs. 1 - 14D).

Petitioner response in the instant petition includes a statement that the drawings found to be missing from the application "are not necessary for the understanding of the invention" (Petition

at pages 1 - 2).

Thus, Petitioner contends, drawings are not necessary for the understanding of the subject matter to be patented.

It is the practice of the Office to treat an application that contains at least one process or method claim as an application for which a drawing is not necessary for the understanding of the invention under 35 U.S.C. §113 (first sentence). (See: MPEP §601.01¹)

This application contains method claims, e.g., claims 1 - 18. Therefore, the application should have been treated as an application filed without all of the drawing figures referred to in the specification as discussed in MPEP §601.01(g).²

¹ The commentary at MPEP §601.01 provides in pertinent part:

* * *

601.01(f) Applications Filed Without Drawings

35 U.S.C. 111(a)(2)(B) and 35 U.S.C. 111(b)(1)(B) each provide, in part, that an “application shall include . . . a drawing as prescribed by section 113 of this title” and 35 U.S.C. 111(a)(4) and 35 U.S.C. 111(b)(4) each provide, in part, that the “filing date . . . shall be the date on which . . . any required drawing are received in the Patent and Trademark Office.” 35 U.S.C. 113 (first sentence) in turn provides that an “applicant shall furnish a drawing where necessary for the understanding of the subject matter sought to be patented.”

Applications filed without drawings are initially inspected to determine whether a drawing is referred to in the specification, and if not, whether a drawing is necessary for the understanding of the invention. 35 U.S.C. 113 (first sentence).

It has been USPTO practice to treat an application that contains at least one process or method claim as an application for which a drawing is not necessary for an understanding of the invention under 35 U.S.C. 113 (first sentence). The same practice has been followed in composition applications.

* * *

A nonprovisional application having at least one claim, or a provisional application having at least some disclosure, directed to the subject matter discussed above for which a drawing is usually not considered essential for a filing date, not describing drawing figures in the specification, and filed without drawings will simply be processed for examination, so long as the application contains something that can be construed as a written description. A nonprovisional application having at least one claim, or a provisional application having at least some disclosure, directed to the subject matter discussed above for which a drawing is usually not considered essential for a filing date, describing drawing figure(s) in the specification, but filed without drawings will be treated as an application filed without all of the drawing figures referred to in the specification as discussed in MPEP § 601.01(g), so long as the application contains something that can be construed as a written description. In a situation in which the appropriate Technology Center (TC) determines that drawings are necessary under 35 U.S.C. 113 (first sentence) the filing date issue will be reconsidered by the USPTO.

* * *

² The commentary at MPEP §601.01 provides in pertinent part:

* * *

601.01(g) Applications Filed Without All Figures of Drawings

The Office of Initial Patent Examination (OIPE) reviews application papers to determine whether all of the figures of the drawings that are mentioned in the specification are present in the application. If the application is filed without all of the drawing figure(s) referred to in the specification, and the application contains something that can be construed as a written description, at least one drawing, if necessary under 35 U.S.C. 113 (first sentence), and, in a nonprovisional application, at least one claim, OIPE will mail a “Notice of Omitted Item(s)” indicating that the application papers so deposited have been accorded a filing date, but are lacking some of the figures of drawings described in the specification. The mailing of a “Notice of Omitted Item(s)” will permit the applicant to either: (1) promptly establish prior receipt in the USPTO of the drawing(s) at issue (generally by way of a date-stamped postcard receipt (MPEP § 503)); or (2) promptly submit the omitted drawing(s) in a nonprovisional application and accept the date of such submission as the application filing date. An applicant asserting that the drawing(s) was in fact deposited in the USPTO with the application papers must, within 2 months from the date of the “Notice of Omitted Item(s),” file a petition under 37 C.F.R. 1.53(e) with the petition fee set forth in 37 C.F.R. 1.17(h), along with evidence of such deposit (37 C.F.R. 1.181(f)). The petition fee will be refunded if it is determined that the drawing(s) was in fact received by the USPTO with the application papers deposited on filing.

* * *

It appears that a "Notice of Omitted Items" should have been mailed instead of the "Notice of Incomplete Nonprovisional Application."

Therefore, the 27 May, 2004, "Notice of Incomplete Nonprovisional Application" hereby is vacated.

The application is accorded a filing date of 3 March, 2004.

The petition is granted in part, to the extent that the application will be accorded the filing date of 3 March, 2004, without the 32 sheets of drawings containing Figures 1 - 14D as part of the original disclosure of the application; in all other respects the petition is dismissed.

The application file is being released to the Office of Initial Patent Examination for further processing with a corrected filing date of 3 March, 2004, indicating in the Office records that "0" sheets of drawings were present on filing, and the mailing of a corrected filing receipt.

Telephone inquiries concerning this decision may be directed to the undersigned at (703)305-9199.



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